The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte BETTINA JACKWERTH, THOMAS GASSENMEIER, CRISTINA AMELA CONESA and ESTHER PRAT QUERALT

Appeal No. 2003-0942
Application No. 09/831,431

ON BRIEF

Before WILLAM F. SMITH, SCHEINER, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 11-22.

Claims 11 and 22 are representative of the subject matter on appeal, and are set forth below:

11. A process for treating human skin and hair comprising contacting the skin or hair with an aqueous composition containing:

(a) an esterquat;
(b) an oil component;
(c) a fatty alcohol; and
(d) a fatty alcohol polyglycol ether.

22. A process for treating human skin and hair comprising contacting the skin or hair with an aqueous composition containing:

(a) from about 5 to 15% by weight of an esterquat;
(b) from about 5 to 50% by weight of an oil component;
(c) from about 5 to 50% by weight of a fatty alcohol; and
(d) from about 5 to 50% by weight of a fatty alcohol polygycol ether,

all weights being based on the total weight of the composition.

The examiner relies upon the following references as evidence of unpatentability:

Prat et al. (Prat)	5,718,891	Feb. 17, 1998
Ponsati Obiols et al. (Ponsati Obiols)	5,880,299	Mar. 9, 1999
Inman et al. (Inman)	5,935,561	Aug. 10, 1999

Claims 11-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Prat in view of Ponsati Obiols and Inman. We vacate the examiner's rejection and make a new ground of rejection under 35 U.S.C. § 103.

OPINION

It is apparent that neither appellants nor the examiner considered the disclosure of Ponsati Obiols in the context of making a patentability determination under § 103 in the manner required by Graham v. John Deere Co., 86 S.Ct. 684, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). If either had, we believe they would have discovered that Ponsati Obiols describes a method for treating human skin and hair which comprises using a composition containing the four components set forth in claim 11. In fact, the examiner's consideration of Ponsati Obiols is based upon erroneous fact finding. The examiner makes reference to Paper No. 6 for the statement of the rejection. Examiner's Answer, page 3. Turning to Paper No. 6 we find that in describing Ponsati Obiols the examiner states "[t]he reference lacks the requirement of the oil components." Id., page 3. However, Ponsati Obiols specifically states at column 5, lines 38-56 that the hair-care and body-care formulations of that invention may include "oils." Claim 11 in relevant part requires nothing more.

The determination that Ponsati Obiols is more relevant than appreciated by appellants and the examiner renders all of appellants' arguments on appeal moot. Under these circumstances we find it a more efficient use of the agency's resources and

fairer to appellants to vacate the examiner's rejection and make the following new ground of rejection.

New Ground of Rejection Under 37 CFR § 1.196(b)

Claims 11-22 are rejected under 35 U.S.C. § 103(a). As evidence of obviusness we rely upon Ponsati Obiols.

1. Claim 11

Ponsati Obiols describes compositions that can be used for treating human skin and hair. See, e.g., column 5, line 38 ("Hair-care and body-care formulations"). Turning to the composition required by claim 11, we find the esterquat is described in column 1, line 35 through column 3, line 39, and in column 4, beginning at line 32. The oil of claim 11 is described at column 5, lines 38-56. In this regard, we note that the oils of Ponsati Obiols can be Guerbet alcohols based on fatty alcohols containing 6-18 and preferably 8-10 carbon atoms. These are the same kinds of oil components described in appellants' specification at the bottom of page 4 and the top of page 5. The fatty alcohol of claim 11 is described in column 3, at lines 52-67. Finally, the fatty alcohol polyglycolether of claim 11 is described in column 4, lines 59 through column 5, line 3 of Ponsati Obiols.

The real issue on appeal in regard should have been whether Ponsati Obiols describes the method required by claim 11 with the

specificity required by 35 U.S.C. § 102, or whether the description of the claimed method in the reference only establishes a prima facie case of obviousness. As stated in In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972):

> Thus, for the instant rejection under 35 U.S.C. 102(e) to have been proper, the Flynn reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. Such picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the *similarity* of the subject matter which he claims to the prior art, but it has no place in the making of a 102, anticipation rejection.

We need not decide whether Ponsati Obiols describes the method of claim 11 in the sense of § 102 since appellants did not rely upon objective evidence of non-obviouness in rebuttal of the now vacated § 103 rejection of the examiner. Ponsati Obiols, at the least, suggests the method set forth in claim 11 to one of ordinary skill in the art. This determination renders moot all of appellants' arguments on appeal as they do not take into account the entire teachings of Ponsati Obiols.

2. Claims 12-14, 16 and 19-22

Turning first to claim 22, we find that Ponsati Obiols teaches that the amounts of components vary according to the

formulation desired (e.g., use as a hair care product versus a body care formulation, etc.). See, e.g., column 5, lines 31-37 and the numerous specific compositions set forth in Tables 1-1D. It is apparent that the precise amounts of the various components to be used in a given composition according to Ponsati Obiols are result effective variables. As such, one of ordinary skill in the art would routinely optimize the relative amounts of the components in implementing the methods for treating human skin and human hair taught by Ponsati Obiols. In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980).

We reach the same conclusion in regard to the amount and ratio limitations set forth in dependent claims 12-14 and 19-22. The specific amounts and proportions the four enumerated components should be present in a particular formulation according to Ponsati Obiols would be routinely optimized by one of ordinary skill in the art.

3. Claims 15, 17 and 18

Claim 15 requires that the fatty alcohol be cetearyl alcohol while claim 17 requires that the fatty alcohol polyglycol ether is a cetearyl ethoxylate having 1 to 20 moles of ethylene oxide. Claim 18 requires that both the fatty alcohol and the fatty alcohol polyglycol ether have identical fatty acid residues, e.g. cetearyl.

Ponsati Obbiols describes a "hair rinse" formulation in Table 1 which contains both cetearyl alcohol and cetear[e]th-20. Ceteareth-20 is a cetyl/stearyl ether. See, e.g., Labeling information for "Eumulgin® B 2" obtained from the web site ww.cognis.com.[1] Cetearyl alcohol is a 1:1 mixture of cetyl and stearyl alcohol. Specification, page 6, lines 12-14.

The noted hair rinse composition in Ponsati Obiols meets the limitations of claims 15 and 18 as it contains both cetearyl alcohol and ceteareth-20. We believe it also meets the limitation of claim 17 as the nomenclature used suggests that the compound contains 20 moles of ethylene oxide.[2]

Time Period For Response

This opinion contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, a new ground of rejection shall not be considered final for purposes of judicial review.

37 CFR § 1.196(b) also provides that appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection

[1] http://www.products.cognis.com/cognis/prodleaf.nsf/($ProductsbyDocID_PL-Header)/REFAAAED7DB422A2EC141256B7A00442F44/$file/EUMULGIN_r_B_2_E.pdf. Web site accessed September 25, 2003. Copy attached.

[2] Since the real party in interest in this appeal is Cognis, this fact should admitted or denied by appellants if prosecution is resumed. Any denial should

to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

Vacated; 196(b)

William F. Smith)
Administrative Patent Judge)
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)
Toni R. Scheiner) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
Beverly A. Pawlikowski)
Administrative Patent Judge)

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be accompanied by factual evidence establishing the specific chemical identity of ceteareth-20.

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